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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/772,246	02/06/2004	Per Sjoberg	20459-00346-US1	6881

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EXAMINER

MILLER, EDWARD A

ART UNIT PAPER NUMBER

3641

DATE MAILED: 07/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/772,246

Applicant(s)

SJOBERG, PER

Examiner

Edward A. Miller

Art Unit

3641

2

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8-22 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 8-22 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 06 February 2004.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

Art Unit: 3641

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 15-17 and 20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

In these claims, per cent amounts of guanidine dinitramide specified, such as "20% to 80% by weight of the gas releasing composition, not including binder," [emphasis added] e.g., the amounts in combination with the "not including binder" limitation, are new matter. To the extent that applicant refers to the drawing, the drawing only relates to the A and B ingredients, not the amounts of A and B in the total composition, so such reliance is misplaced. Applicants are required to point out the original specification basis therefore or to cancel the new matter. The new language, each word *arguendo* having basis, is such that the new concept, or the new expression as a whole, lacks original basis, when fairly viewed in context. Compare *In re Oda*, 170 USPQ 268, and *Ex parte Grasselli*, 231 USPQ 393, as well as MPEP 706.03(o) and 2163-2163.06, where departures (including from cancellations, where each word has basis, but not the expression) from the original disclosure are new matter. Also, as to ranges of ingredients, see *Ex parte Jackson*, 110 USPQ 561. Here, claim 8 recites a pyrotechnic composition "comprising guanidine dinitramide and guanyl urea dinitramide." Due to the "comprising" scope, additional ingredients and in any amounts are permitted. This is particularly the case in view of the "not including binder" limitation. No basis is set forth for this.

Art Unit: 3641

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 8-22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims are indefinite. As best understood, claim 8 recites a composition with A (guanidine dinitramine) and B (guanyl urea dinitramine). However, claim 10 recites that the A "comprises greater than 50%". By the well known case law, this open ended range includes 100%. This is inconsistent with claim 8 requiring both A + B. Claims such as 18-22, in and of themselves fail to define a safety device. They are incomplete for omitting essential elements, such omission amounting to a gap between the elements. See MPEP § 2172.01. The omitted elements are: all parts of the device but for the composition. There is no recitation of any parts or apparatus content of the apparatus.

In claim 9, line 3, the term "suitable" is used, without any manner of, or parameters for, determining a "suitable" amount. Assuming arguendo that the two different substances recited in claim 8 have different burning rates, the claim 9 limitation is not a further limitation, but would be inherently always the case, as written. Should the burning rates be identical, then the claim 9 limitation would never be true. In any event, claim 9 as written is indefinite, and appears improper as failing to further limit the subject matter of claim 1, 35 USC 112, 4th paragraph. In a like manner, claim 18 is indefinite as it is not clear how a method of use limits the composition of claim 8. Alternatively, claim 18 provides for the use of the composition, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is

Art Unit: 3641

intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

In claim 12, "the gas-releasing substance" lacks antecedent basis in claim 8.

The claims are generally narrative and indefinite, and fail to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with errors. The above are exemplary; the claims should be completely revised to be in accord with US practice.

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claim 18 is rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 8-22 are rejected under 35 U.S.C. 103(a) as obvious over Blomquist, 6,004,410, in view of Langlet, WO 98/55428.

Blomquist '410 teaches airbag devices containing [provided with] GDN (guanidine dinitramide), for example, at col. 2, line 32. In the instant claims, a suitable amount of guanidine

Art Unit: 3641

dinitramide may be 100%, over 50% from claim 10, to obtain the examiner's desired burning rate. Likewise, "possible" amounts of binder include 0%, especially in claims 15-17, and more than 50% of GDN includes 100%. Thus, possibly no claims but claims 15-17 and 20-22 require any additional ingredient beyond GDN. This is problematic due to the indefinite nature of the claims. To the extent appropriate, Blomquist '410 may be the epitome of obviousness, anticipation, as broadly construed. *In re Pearson*, 181 USPQ 641 (CCPA 1974). The claim 12 "tablet" form is taught at col. 4, lines 63-67. In any event, it would have been clearly obvious to combine a plurality of ingredients to prepare a gas generating composition, where the properties of use in such are well known and the combination produces the expected result, a safety device of some utility. Thus, the device produced is an unspecified safety device having a propellant or gas generating material. There is nothing unobvious about preparing such devices, including by providing the propellant therefore. Langlet, WO 98/55428, teaches the similar use of guanylurea dinitramide for the same purpose as the GDN of Bloomquist '410. Thus, combining the ingredients or the compositions to obtain the desired average of properties would have been obvious. Where the ingredients are well known and combined for their known properties, the combination is obvious, absent unexpected results, *In re Crocket*, 126 USPQ 186, *In re Pinten*, 173 USPQ 801, and *In re Sussman*, 43 CD 518. Further, it is prima facie obvious to combine two compositions, each taught for the same purpose, to yield a third composition for that very purpose. *In re Kerkhoven*, 205 USPQ 1069, *In re Pinten*, 173 USPQ 801, and *In re Susi*, 169 USPQ 423.

To the extent appropriate, variation of specific amounts and well known ingredients would have been obvious to one of ordinary skill in the art. It is well settled that optimizing a result effective variable is well within the expected ability of a person of ordinary skill in the subject art. *In*

Art Unit: 3641

re Boesch, 617 F.2d 272, 205 USPQ 215 (CCPA 1980), *In re Aller*, 220 F.2d 454, 105 USPQ 233 (CCPA 1955).

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edward A. Miller whose telephone number is (703) 306-4163. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Carone can be reached on (703) 306-4198. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Miller/em
June 28, 2004

A handwritten signature in black ink, appearing to read 'Edward A. Miller', with a long horizontal flourish extending to the right.

EDWARD A. MILLER
PRIMARY EXAMINER